

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Scott MILLER *et al.*

Serial No.: 09/776,936

Filed: December 22, 1998

For:

**INHIBITION OF RAF KINASE USING SYMMETRICAL AND  
UNSYMMETRICAL SUBSTITUTED DIPHENYL UREAS**



Group Art Unit: 1621

Examiner: Kumar, S.

#7 1621  
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**RESPONSE TO RESTRICTION REQUIREMENT**

I hereby certify that this correspondence is being deposited  
with the U.S. Postal Services as First Class Mail in an envelope  
addressed to Assistant Commissioner for Patents  
Washington, D.C. 20231 On: October 26, 2001

Name: Richard J. Traverso

SIGNATURE

DATE

October 26, 2001

Assistant Commissioner for Patents  
Washington, D.C. 20231

SIR:

In response to the Office Action dated September 26, 2001, requiring restriction of the application to one of three groups of claimed subject matter, Applicants elect Group I (claims 1-19) drawn to compounds, compositions and methods of use wherein the compounds are non-heterocyclic.

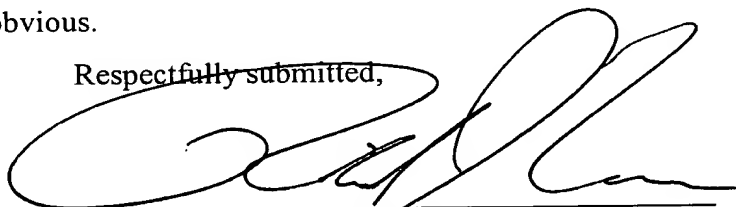
Applicants acknowledge the compounds of Groups I, II, and III have some structural differences but they also have significant structural similarities based on which, they should be examined together. All of the claimed compounds have urea functionality and a phenyl group. With this common link, Applicants submit that all the claimed subject matter should be examined together.

Applicants also submit that the restriction requires subject matter within a single claim to be withdrawn from examination, which is improper in view of In re Weber, 580 F.2d 455, 198 USPQ 328 (CCPA 1978). The proper procedure for limitation of examination of subject matter in a single claim is to require an election of species. See MPEP Section 803.02. If prior art is found, the claims can be rejected based on these references. If no prior art is found to anticipate

or render obvious the elected species, the search can be extended to other subject matter within the claims. Requiring restriction as set forth here would not allow for examination to continue if the elected subject matter is found to be novel and unobvious.

The Office Action also requires an election of a single species, which is consistent with the requirement of MPEP 803.02. Applicants elect the compound identified as "20" in the tables of the specification, which is N-5-tert-butyl-phenyl-N'-(3-(4-pyridyloxy)phenyl) urea. Applicants submit the examination should be extended to other subject matter when the elected compound is found to be novel and unobvious.

Respectfully submitted,



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